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Brian P. Kinnear
HOLLLAND & HART LLP
555 17th Street, Suite 3200
P.O. Box 8749
Denver, Colorado 80201-8749

In re Application of :
ALLAIRE et al. :
Application No.: 09/673,922 : DECISION ON REQUEST
PCT No.: PCT/US99/08870 :
Int. Filing Date: 22 April 1999 :
Priority Date: 22 April 1998 :
Attorney Docket No.: 39573.830003 :
For: HYBRID MAGNETICALLY SUSPENDED
AND ROTATED CENTRIFUGAL PUMPING
APPARATUS AND METHOD

This decision is in response to applicants' "Petition to Correct Inventorship Under 37 CFR 1.48(a)" which is being treated as a request under 37 CFR 1.497(d); "Petition Under 37 CFR 1.183 for Waiver of Assignee Consent;" and "Petition Under 37 CFR 1.183 for Waiver of a New Oath" filed 08 December 2000.

BACKGROUND

On 22 April 1999, applicants filed international application No. PCT/US99/08870 which claimed a priority date of 22 April 1998 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 October 1999. The international application named Paul Allaire, Gill Bearnson, Ron Flack, Don B. Olsen, James W. Long, B. Ajit Kimar; Pratap S. Khanwilkar, Jeffrey Decker, and Michael Baloh as inventors. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 22 October 2000.

On 20 October 2000, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and an oath and declaration.

On 08 November 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 20 October 2000 was defective because inventors Jeffrey Decker and Michael Baloh names and signatures were missing from the declaration. Additionally, the declaration was executed by M. Mary Sinnott, who has not been named in the international application. The notification set a one month time limit in which to respond.

On 08 December 2000, applicants filed "Petition to Correct Inventorship under 37 CFR 1.48(a);"
"Petition Under 37 CFR 1.183 for Waiver of Assignee Consent," and "Petition Under 37 CFR 1.183 for
Waiver of a New Oath."

DISCUSSION

A. Submission Under 37 CFR 1.497(d)

In the instant case, the international application named Paul Allaire, Gill Bearnson, Ron Flack, Don B. Olsen, James W. Long, B. Ajit Kimar; Pratap S. Khanwilkar, Jeffrey Decker, and Michael Baloh as inventors. Applicants request to delete Michael Baloh and Jeffrey Decker as inventors and add M. Mary Sinnott as an inventor. In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a submission under 37 CFR 1.497(d) is required.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

- (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a);
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants have satisfied item (3).

In order to satisfy item (1), applicants must submit a statement by Michael Balof, Jeffrey Decker, and M. Mary Sinnott that the error in inventorship occurred without any deceptive intention on their part.

In regards to item (2), the declaration submitted 08 December 2000 is defective in that the declaration does not identify the application which it is directed. The declaration provided identifies Serial No. 09/064,352." A declaration has not been filed for this particular application (09/673,992). (See 37 CFR 1.63.)

Further, in order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship in compliance with 37 CFR 3.73(b), if the instant application has been assigned, or, in the alternative, a statement that the application has not been assigned.

B. Submission Under 37 CFR 1.183

Applicant have filed a Petition Under 37 CFR 1.183 for Waiver of Assignee Consent and Waiver of a New Oath. "In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee

set forth in 1.17(h)."

In the present circumstances, applicants have not exhausted the remedies available to them and have failed to establish that an extraordinary situation exists and that justice requires the requested waiver. For this reason applicants' request for waiver is inappropriate.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

For the reasons discussed above, applicants' request under 37 CFR 1.183 is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

A proper response must include a proper declaration in compliance with 37 CFR 1.497 (a) and (b) executed by all of the named inventors, statements from those inventors being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part, and a written consent of assignee in compliance with 37 CFR 3.73(b) or, in the alternative, a statement that the application has not been assigned.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Richard Cole
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Tel: (703) 308-6314
Fax: (703) 308-6459